

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL J. FERRIGAN

Appeal No. 97-0746
Application 08/135,883¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, and
MEISTER and FRANKFORT, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final
rejection of claims 1 through 6. No other claims are pending

¹Application for patent filed October 13, 1993.

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in the application.

The subject matter here claimed is "[a] rack for storing removable automobile hardtops and the like . . ."² (claim 1, line 1). According to claim 1, the only independent claim on appeal, the rack comprises a pair of L-shaped members each pivotably mounted on a lower end of a vertical frame to facilitate independent arcuate movement of forward portions of the L-shaped members about a common axis and in substantially vertical and parallel planes from horizontal positions to vertical positions.

A copy of the appealed claims is appended to appellant's brief.

The following references are relied upon by the examiner as evidence of anticipation and obviousness in support of his rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103:

²The recitation "and the like" and similar expressions ordinarily are regarded as being indefinite. See Ex parte Caldwell, 1906 Dec. Comm'r Pats. 58 (Comm'r Pats. 1905) and Ex parte Kristensen, 10 USPQ2d 1701 (Bd. Pat. App. & Int. 1989). However, in the present case, it is apparent that when the expression "and the like" is read in light of appellant's specification, it refers to other body panels.

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Plumly	3,132,875	May 12, 1964
Grant	3,230,908	Jan. 25, 1966
Pfister	4,153,264	May 08, 1979
Ferrigan et al. (Ferrigan)	5,221,066	Jun. 22, 1993

The grounds of rejection are as follows:

1. Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Pfister.

2. Claims 1 and 2 additionally stand rejected under 35 U.S.C. § 103 as being unpatentable over "Pfister (fig. 7) in view of Pfister (fig. 1)" (answer, page 3).

3. Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Pfister in view of Grant.

4. Claims 1 through 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Plumly in view of Ferrigan and Grant.

Reference is made to the examiner's answer for details of these rejections.

We have carefully considered the issues raised in this appeal together with the examiner's remarks and appellant's arguments. As a result, we conclude that none of the rejections of the appealed claims is sustainable.

In support of his § 102(b) rejection, the examiner relies on the embodiment shown in Figures 1-6 of the Pfister patent. As noted on page 4 of his answer, he reads appellant's L-shaped members on Pfister's two L-shaped shaft assemblies each having shaft elements 42 and 82. He also reads appellant's vertical frame on Pfister's structural member 12 which is described in the patentee's specification as a "vertical frame member" (specification, column 2, line 47). However, Pfister discloses that his L-shaped shaft assemblies are fixed by a clamp 44 to a

mid region of his vertical frame member 12 (see, for example, Figure 1 of Pfister's patent drawings), not to the lower end of the vertical frame as required by appealed claim 1.

Accordingly, Pfister is not a proper anticipatory reference for the subject matter of claim 1 and of claim 2, which depends from claim 1. Compare Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986) (The absence from the reference of any element of a claim negates anticipation of that claim by the applied

reference). We therefore must reverse the § 102 (b) rejection of claims 1 and 2.

With regard to the examiner's § 103 rejection of claims 1 and 2 based on Figures 1 and 7 of the Pfister patent, the examiner is understood to conclude that it would have been obvious to replace Pfister's one piece cross shaft 142 with a two piece assembly corresponding to the patentee's embodiment of Figure 1 "to enable independent adjustment" (answer, page 5). Pfister's separate shaft assemblies (42, 82), however, are not employed to provide "independent adjustment" as suggested by the examiner. Instead, these shaft assemblies are separable to enable the wheel assemblies 40L and 40R to be collapsed for storage in the manner shown in Figure 5 of Pfister's drawings. In any event, even if Pfister's embodiment of Figure 7 were modified in the

manner proposed by the examiner, the modified structure still would not meet the terms of claim 1 because in both of the patentee's embodiments, the cross shaft structure is fixed to the mid region of the vertical frame 12, not to the lower end thereof as required by claim 1.

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In the final analysis, the only way the examiner could have arrived at his conclusion of obviousness in light of the Pfister patent is through hindsight based on appellant's teachings. Hindsight analysis, however, is clearly improper. In re Deminski, 796 F.2d 436, 443, 230 USPQ 313, 316 (Fed. Cir. 1986). Accordingly, we must reverse the § 103 rejection of claims 1 and 2 based on the Pfister patent.

With regard to the § 103 rejection of claim 4 based on the combined teachings of Pfister and Grant, Grant is relied on by the examiner for a teaching of a pin and slot arrangement to facilitate limited relative rotation between two telescoping tubular members. This rejection also must be reversed inasmuch as Grant does not rectify the foregoing deficiencies of Pfister.

With regard to the rejection of the appealed claims based on the combined teachings of Plumly, Ferrigan and Grant, we cannot

agree with the examiner's conclusion that the teachings of Ferrigan would have made it obvious to replace Plumly's U-shaped frame member 12 with "independent wheel frames with wheel [sic, wheels] attached as claimed to facilitate storage" (answer, page 4).

In the first place, Plumly expressly discloses in column 3, lines 4-10, that his handle and post unit 42, 44 is pivotable to a collapsed position over frame 12 for storing the dolly. Accordingly, there would be no reason to replace Plumly's frame 12 with independently pivotable members for accomplishing a purpose already achieved with the patentee's structure. Furthermore, to select Ferrigan's teaching of providing independently pivotable frame members, but not Ferrigan's teaching of pivoting the frame members about angularly intersecting axes, and then to combine that selected teaching with Plumly's teachings in such a way to pivot the members about a common axis amounts to a piecemeal reconstruction of appellant's claimed invention based on the impermissible hindsight benefit of appellant's own disclosure. For these reasons we must reverse the 103 rejection of claims 1 through 6 based on the combined

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teachings of Plumly, Ferrigan and Grant.

The examiner's decision rejecting the appealed claims is
reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
)	
)	
)	
JAMES M. MEISTER)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

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